

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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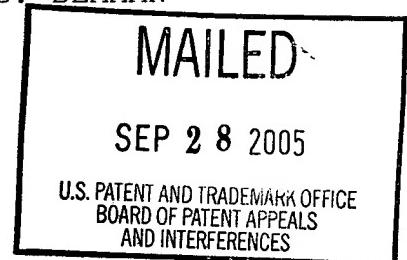
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte DAVID G. OPSTAD and ALEXANDER B. BEAMAN

Appeal No. 2005-1656  
Application No. 09/306,888

ON BRIEF



Before RUGGIERO, DIXON, and MACDONALD, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 1-9, 11-13, 16-20, 22-27, and 29-31. Claims 10, 14, 15, 21, and 28 have been indicated by the Examiner to be allowable subject to being rewritten in independent form to include all the limitations of the base claim and any intervening claims.

Appeal No. 2005-1656  
Application No. 09/306,888

The claimed invention relates to a method and system for automatically synthesizing data tables that are required for proper processing of font glyphs. Upon request by an application program to display or print a character or a string of text, a computer's font system checks the original font definition to determine if the data tables necessary for proper display or printing are present either in the font definition itself or in an associated annex file. If the data tables exist, the tables are accessed and the data is used to process the font data. If the data tables do not exist, they are automatically synthesized and placed in the annex, where the data is then utilized for processing.

Claim 1 is illustrative of the invention and reads as follows:

1. A method for generating an image of a sequence of characters, comprising the steps of:

    retrieving glyphs from a font which correspond to characters in a string of characters;

    determining whether the font contains a predetermined data table that pertains to the layout of glyphs;

Appeal No. 2005-1656  
Application No. 09/306,888

automatically synthesizing said data table, based upon data contained in the font, if the font is determined not to contain said data table;

laying out the glyphs in a line, in accordance with the data in said table; and

generating an image of the laid-out line of glyphs.

The Examiner relies on the following prior art:

Sonnenschein	5,500,931	Mar. 19, 1996
		(filed: Jul. 10, 1995)
Patel et al. (Patel)	6,426,751	Jul. 30, 2002

Claims 1-9, 11-13, 16-20, 22-27, and 29-31, all of the appealed claims, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sonnenschein in view of Patel.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments

Appeal No. 2005-1656  
Application No. 09/306,888

set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1-9, 11-13, 19, 20, 22-27. We reach the opposite conclusion with respect to the Examiner's obviousness rejection of claims 16-18 and 29-31. Accordingly, we affirm-in-part.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some

Appeal No. 2005-1656  
Application No. 09/306,888

teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 11, 19, and 26 based on the combination of Sonnenschein and Patel, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After

Appeal No. 2005-1656  
Application No. 09/306,888

reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

Initially, our interpretation of the disclosure of Sonnenschein coincides with that of Appellants. As asserted by Appellants (Brief, pages 7-11; Supplemental Brief, page 4), Sonnenschein is fundamentally different from the invention as claimed since, in contrast to the claimed invention, Sonnenschein is not concerned with creating or synthesizing tables for a font because Sonnenschein is always looking for other fonts to represent a character if a current font for that character is not found. As a consequence, Sonnenschein never makes a determination whether a font contains a necessary table since Sonnenschein operates under the assumption that each font definition already contains the necessary data tables.

We further agree with Appellants that the Patel reference does not make up for the deficiencies of Sonnenschein. As pointed out by Appellants (Brief, page 12; Supplemental Brief, pages 5 and 6), the Patel reference, which is directed to adding features to an existing font file or creating a new font file

Appeal No. 2005-1656  
Application No. 09/306,888

with user-specified features lacks any teaching or suggestion of making a determination as to whether a particular font contains a predetermined data table, a feature present in each of independent claims 1, 11, 19, and 26.

Accordingly, since we are of the opinion that the Examiner has not established a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied Sonnenschein and Patel references, we do not sustain the rejection of independent claims 1, 11, 19, and 26 nor of claims 2-9, 12, 13, 20, 22-25, and 27 dependent thereon.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of claims 16-18 and 29-31 based on the combination of Sonnenschein and Patel, we note that, while we found Appellants' arguments to be persuasive with respect to the Examiner's rejection of claims 1-9, 11-13, 19, 20, and 22-27 discussed supra, we reach the opposite conclusion with respect to the obviousness rejection of claims 16-18 and 29-31. With respect to independent claims 16 and 29, we make the observation that, unlike the limitations set forth in independent claims 1, 11, 19, and 26, there is no recitation of the feature of

Appeal No. 2005-1656  
Application No. 09/306,888

determining whether a particular font contains necessary tables for implementation of the font. Rather, claims 16 and 29 are directed to the features of building a font map, determining relationships among the font map information items, and constructing a table identifying the relationships.

With the above discussion in mind and reviewing Appellants' arguments (Brief, pages 13-15; Reply Brief, page 5) in response to the obviousness rejection, we simply find no arguments which convince us of any error in the Examiner's stated position. In particular, we find noteworthy Appellants' characterization (Brief, page 13, Supplemental Brief, page 5), with which we generally agree, of the system described by Patel. As alluded to by Appellants, Patel describes a system in which fonts are modified or created, relationships are determined, and tables are constructed identifying the relationships which, in our view, would satisfy the requirements of claims 16 and 29. Even if Appellants are correct in their contention (Supplemental Brief) that the operations in Patel take place before the implementation of a font, we see nothing in the language of claims 16 and 29 which would preclude such an occurrence. Further, although we do

Appeal No. 2005-1656  
Application No. 09/306,888

not necessarily agree with Appellants' argument (Reply Brief, page 5) that the preamble of claim 16 "breathes life" into the claim as a whole and therefore must be taken into characterization, we find nothing in the "automatically synthesizing" language which would distinguish over that disclosed in particular by Patel.

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 16 and 29, as well as claims 17, 18, 30, and 31 dependent thereon and not separately argued by Appellants, is sustained.

In summary, with respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 1-9, 11-13, 16-20, 22-27, and 29-31, we have sustained the rejection of claims 16-18 and 29-31, but have not sustained the rejection of claims 1-9, 11-13, 19, 20, 22-27. Therefore, the Examiner's decision rejecting claims 1-9, 11-13, 16-20, 22-27, and 29-31 is affirmed-in-part.

Appeal No. 2005-1656  
Application No. 09/306,888

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004).

AFFIRMED-IN-PART

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Appeal No. 2005-1656  
Application No. 09/306,888

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